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FEB 20 2004

OFFICE OF PETITIONS

Applicant: Plenderleith  
Appl. No.: 09/989,351  
Filing Date: November 20, 2001  
Title: SPORTS VEHICLE  
Attorney Docket No.: 717901.16  
Pub. No.: US 2002/0030331 A1  
Pub. Date: March 14, 2002

This is in response to the request for correction of patent application publication under 37 CFR 1.221(b), which was filed on May 14, 2002.

The request is DISMISSED.

The instant request is that the application be republished because the patent application publication incorrectly includes deleted words bracketed throughout the application, which were deleted in the preliminary amendment and were shown in the marked-up copy that was submitted with the preliminary amendment.

37 CFR 1.221(b) is applicable "only when the Office makes a material mistake which is apparent from Office records." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.<sup>1</sup> The instant request does not identify a material mistake in the publication made by the Office:

The patent application publication does not include a mistake in the publication by the Office because patent application publications do not include preliminary amendments, according to 37 CFR 1.215(a), which says the following, in part:

(a) ... The patent application publication will not include any amendments, including preliminary amendments, unless applicant supplies a copy of the application containing the amendment pursuant to paragraph (c) of this section.

§ 1.215(c) says the following:

(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and oath or declaration) as amended during examination, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the actual filing date of the application or fourteen months of the earliest filing date for which is sought under title 35, United States Code, whichever is later.

<sup>1</sup>Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

The applicant did not supply a copy of the application in compliance with § 1.215(c). The Office correctly published the application in accordance with § 1.215(a).

In order to publish an application with “amendments” without submitting a copy of the application through the Electronic Filing System (EFS), applicant should file a new specification and corrected drawings, so long as no matter is included in the new specification and corrected drawings that would have been new matter in the prior application. Thus, the new specification and corrected drawings may include some or all of the amendments entered during the prosecution of the prior application(s), as well as additional amendments submitted for clarity or contextual purposes, and a new set of claims.<sup>2</sup> Applicant may want to additionally submit a marked-up copy of the application for the Examiner but an amendment to the specification is not filed, as the application is filed with the “amendments” included.

If the errors in the publication were Office errors, they would not have been considered material errors, as required by 37 CFR 1.221(b). The instant request identifies minor “errors” in the publication, as amendments to the specification are shown in the publication, as applicant filed the application with a preliminary amendment and a marked-up copy, which was used to create the patent application publication. These “errors” are not material mistakes because the technical disclosure and the claims are understandable. The errors do not affect the public’s ability to appreciate the technical disclosure of the patent application publication, or determine the scope of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.

The applicant is advised that a “request for republication of an application previously published” may be filed under 37 CFR 1.221(a). Such a request for republication “must include a copy of the application in compliance with the Office’s electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i).” If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

Any request for republication under 37 CFR 1.221(b), should be submitted via the EFS system and questions or request for reconsideration of this decision, should be addressed as follows:

By mail to: Mail Stop PGPUB  
Commissioner for Patents  
P.O. Box 1450  
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The application is being forwarded to Technology Center 3618 to await further examination in due course.

Inquiries relating to this matter may be directed to Mark Polutta at (703) 308-8122 (voice) or (703) 746-3465 (facsimile).

Mrs. Patti

Mark O. Polutta  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy

<sup>2</sup>See Pre-Grant Publication Helpful Hint: File Continuation or Divisional Application with a New Specification and Copy of Oath or Declaration from Prior Application, 1251 Off. Gaz. Pat. Office Notices 54 (Oct. 9, 2001).